UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,464	10/30/2003	Julian Mitchell	920476-95004	7959

23644   7590   04/18/2008
BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

EXAMINER
OVANDO, PABLO R

ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
04/18/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

	Application No.	Applicant(s)
Office Action Summary	10/697,464	MITCHELL ET AL.
	Examiner	Art Unit
	PABLO R. OVANDO	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *30 October 2003*.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-24* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-24* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *30 October 2003* is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some *   c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The disclosure is objected to because of the following informalities: page 6 line
26 recites "network 27". Should it recite "network 30" or is that element missing from
the drawing? Also, page 7, line 20 recites "call server 42". Should it recite "call server
44" or is that element missing from the drawing?

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

1.   **Claim 24** is rejected under 35 U.S.C. 101 because the claimed invention is
directed to non-statutory subject matter as follows. Claim 24 defines a software.
However, the claim does not define a computer-readable medium
or memory and is thus non-statutory for that reason (i.e., when functional descriptive
material is recorded on some computer-readable medium it becomes structurally and
functionally interrelated to the medium and will be statutory in most cases since use of
technology permits the function of the descriptive material to be realized" - Guidelines
Annex IV). That is, the scope of the presently claimed computer program can range
from paper on which the program is written, to a program simply contemplated and

memorized by a person. The examiner suggests amending the claim to embody the

program on "computer-readable medium" or equivalent in order to make the claim

statutory. Any amendment to the claim should be commensurate with its

corresponding disclosure.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out
and distinctly claiming the subject matter which the applicant regards as his
invention.

2.   **Claims 1, 12, 13, 16, 23 and 24** are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.   Claim 1 recites one proxy

between two "ends". What constitutes a "near" end and a "far" end according to claim

1? Also, the language of "corresponding" is vague, corresponding message to what?

Also, "the media proxy is arranged to detect a blocking situation", it is unclear where or

what the "blocking situation" is or what is being blocked? Also, "before forwarding the

corresponding message" is unclear, to where is the message being "forwarded"? Also,

"where another device" is indefinite because there is no first device? Is it assumed that

there is already one device? Claim 12 contains similar unclear language. Additionally,

in claim 12 , the language "sending the message onwards" is vague, where is onwards?

Claim 13 contains similar unclear language. Additionally, line 7, the language "cause

the media proxy" is indefinite, is that the first or second media proxy? Claim 16 contains

the same unclear language as claim 1, and claim 23 contains the same unclear

language as claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1, 2, 6, 8-10, 12, 16, 17, 20-22 and 24** are rejected under 35 U.S.C.

103(a) as being unpatentable over O'Brien et al, US Patent Application Publication

2002/0186685 (hereinafter referenced as O'Brien) in view of Eisenberg et al, US Patent

Application Publication 2003/0188001 (hereinafter referenced as O'Brien).

As to **claim 1**, O'Brien teaches a configuration where a media proxy 26 is

between elements 20, 12, 30 and 34 (paragraphs 22-24). O'Brien teaches that a media

proxy receives a request from a client PC 20 (paragraph 34). O'Brien does not teach

that the media proxy is arranged to detect a blocking situation where another device in

the path is awaiting the first message before forwarding the corresponding message. In

the same field of endeavor, Eisenberg teaches an automatic firewall detection that

detects any firewalls NATs and proxies (paragraph 99-102). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to apply

the teachings of Eisenberg in O'Brien for the purpose of determining the configuration of

the network.

As to **claim 2**, Eisenberg teaches sending a probe message to discover if there

is another media proxy along the path (fig. 10 shows probes being sent out from the

TSP to the proxy).

As to **claim 6**, O'Brien teaches setting up a communication session using a

multimedia control protocol (paragraph 34, note SIP).

As to **claim 8**, O'Brien teaches that the communication session being coupled

through a NAT (paragraph 36).

As to **claim 9**, Eisenberg teaches that the communication session being coupled

to a VPN (abstract).

As to **claim 10**, Eisenberg teaches sending the first message onwards

before receiving the corresponding message from the second end, if the probe

message is acknowledged (paragraph 99-102, note that after the probe is sent, a

connection is established).

As to **claim 12**, O'Brien teaches a configuration where a media proxy 26 is

between elements 20, 12, 30 and 34 (paragraphs 22-24). O'Brien teaches that a media

proxy receives a request from a client PC 20 (paragraph 34). O'Brien does not teach

that the media proxy is arranged to detect a blocking situation where another device in

the path is awaiting the first message before forwarding the corresponding message. In

the same field of endeavor, Eisenberg teaches an automatic firewall detection that

detects any firewalls NATs and proxies (paragraph 99-102). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to apply

the teachings of Eisenberg in O'Brien for the purpose of determining the configuration of

the network.

As to **claim 16**, see similar rejection to claim 1.

As to **claim 17**, see similar rejection to claim 2.

As to **claim 20**, Eisenberg teaches the step of listening for a probe acknowledge

message on the same port used for sending the probe message (paragraph 100).

As to **claim 21**, O'Brien teaches that the communication session being coupled

through a NAT (paragraph 36).

As to **claim 22**, O'Brien teaches offering a communication service through the

media proxy (fig. 1 element 26).

As to **claim 24**, see similar rejection to claim 1.

4.   **Claim 3, 4, 7, 11, 13, 14, 15, 18, 19 and 23** are rejected under 35 U.S.C. 103(a)

as being unpatentable over O'Brien in view of Eisenberg, as applied to claim 1, and in

further view of Ravishankar, US Patent Application Publication 2003/0190032

(hereinafter referenced as Ravishankar).

As to **claim 3**, O'Brien in view of Eisenberg teach everything claimed, as applied to claim 2. Additionally, O'Brien teaches that the probes are sent through a predetermined port (paragraph 100). However, Eisenberg does not teach that the IP is indicated by the call server. In the same field of endeavor, Ravishankar teaches that a call server is used to set up a call and maintain communication with the media proxy (abstract and paragraph 9). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teachings of Ravishankar in the combination of O'Brien and Eisenberg since the result of each of the elements is well known in the art. Additionally, the call server facilitates the setting up of the connection.

As to **claim 4**, Eisenberg teaches that the media proxy is arranged to listen on a predetermined port for probe messages from other entities (paragraph 100).

As to **claim 7**, Eisenberg teaches listening for a probe acknowledge message on the same port used for sending the probe message (paragraph 100).

As to **claim 11**, O'Brien in view of Eisenberg teach sending probes. However, the combination does not teach arranging to receive a probe request from a call server during set up. In the same field of endeavor, Ravishankar teaches a call server 108 used for setup.

As to **claim 13**, O'Brien teaches a configuration where a media proxy 26 is between elements 20, 12, 30 and 34 (paragraphs 22-24). O'Brien teaches that a media proxy receives a request from a client PC 20 (paragraph 34). O'Brien does not teach

that the media proxy is arranged to detect a blocking situation where another device in the path is awaiting the first message before forwarding the corresponding message. Additionally, O'Brien does not teach that a call server is used in setting up a call. In the same field of endeavor, Eisenberg teaches an automatic firewall detection that detects any firewalls NATs and proxies by send probes (paragraph 99-102). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teachings of Eisenberg in O'Brien for the purpose of determining the configuration of the network.

In the same field of endeavor, Ravishankar teaches using a call server to setup a connection and establish a connection using media proxy (abstract and paragraph 9). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teachings of Ravishankar in the combination of O'Brien and Eisenberg since the result of each of the elements is well known in the art. Additionally, the call server facilitates the setting up of the connection.

As to **claim 14**, Ravishankar teaches that the call server is arranged to send an IP address and port for the second media proxy to the first media proxy, to enable the first media proxy to send the first message onwards (abstract, note that the call server sets up a connection using SIP).

As to **claim 15**, Eisenberg teaches sending a probe request to the media proxy in control messaging sent during call set up (paragraph 100).

As to **claim 18**, see similar rejection to claim 3.

As to **claim 19**, see similar rejection to claim 4.

As to **claim 23**, see similar rejection to claim 13

5.   **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien

in view of Eisenberg, as applied to claim 2, and in further view of Tiedemann, US Patent

Application Publication 2003/0199252 (hereinafter referenced as Tiedemann).

As to **claim 5**, O'Brien in view of Eisenberg teach everything claimed, as applied

to claim 2. However, the combination above does not teach waiting a predetermined

time for the corresponding message before sending the probe message. However, in

the same field of endeavor, Tiedemann teaches waiting a predetermined period of time

for an acknowledgment before sending a probe (paragraph 61). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to apply

the teachings of Tiedemann in the combination mentioned above for the purpose of

avoiding congestion.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to PABLO R. OVANDO whose telephone number is

(571)272-9752. The examiner can normally be reached on M-F 7:30 am to 5:00pm,

EST,Alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. R. O./
Examiner, Art Unit 2614

/Ahmad F. MATAR/
Supervisory Patent Examiner, Art Unit 2614